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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/902,081	07/10/2001	Ashwani Chhibber	02581-P0392A	7798

24126 7590 09/24/2002

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EXAMINER

MULCAHY, JOHN M

ART UNIT PAPER NUMBER

3739

DATE MAILED: 09/24/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/902,081

Applicant(s)

CHHIBBER ET AL.

Examiner

John M. Mulcahy

Art Unit

3739

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Art Unit: 3739

Requirement for Information

1. Applicant and the assignee of this application are required under 37 CFR 1.105 to provide the following information that the examiner has determined is reasonably necessary to the examination of this application:

The publication date of the Kaplan et al. document ("The Role of the Universal Video Intubating System in the Management of the Difficult Airway," Endo-Press, 2000) cited by Applicant is requested. Specifically, whether it was published prior to the critical date of July 10, 2000, and whether it was the earliest publication, public use or sale of the subject matter of page 26 thereof.

The applicant is reminded that the reply to this requirement must be made with candor and good faith under 37 CFR 1.56. Where the applicant does not have or cannot readily obtain an item of required information, a statement that the item is unknown or cannot be readily obtained will be accepted as a complete reply to the requirement for that item.

This requirement is an attachment of the enclosed Office action. A complete reply to the enclosed Office action must include a complete reply to this requirement. The time period for reply to this requirement coincides with the time period for reply to the enclosed Office action.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Art Unit: 3739

Claim 10 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phrase "preferably" renders the claim indefinite because it is unclear whether the limitation "2 mm" following the phrase is part of the claimed invention.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

a. Claims 1-10 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Kaplan et al., "The Role of the Universal Video Intubating System in the Management of the Difficult Airway," Endo-Press, 2000, p. 26. For the purposes of this Office Action, it is assumed that the Kaplan et al. document was published prior to the critical date of July 10, 2000.

b. Claims 1-5 and 7 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Shimonaka (JP 55-81317). See Figs. 1, 3, 4, 12, 14 and 15; note English abstract. Note that adapter 17 is adjusted by screw 18-19.

c. Claims 1-4, 6 and 7 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Adair (5,329,940). See Figs. 1-3, 5 and 7; note col. 7, line 46, through col. 8, line 19. Note adapter 48.

d. Claims 1-3 and 8 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by George (4,742,819). See Figs. 1, 2 and 6; note that the shaft is "semi-malleable" (col. 2, line 54).

Claim Rejections - 35 USC § 103

3: The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention, is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

a. Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Adair (5,329,940) as applied to claim 1 above, further in view of Chatenever et al. (WO 98/46117).

Adair fails to locate the camera at the proximal end of the shaft 28. Rather, the camera is in a separate unit 36. However, Chatenever et al. teach an endoscope having a video camera arranged at the proximal end of the shaft and removable therefrom. It would have been obvious to the artisan to modify Adair by using the camera system of Chatenever et al. in order to realize the advantages described therein.

b. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Adair (5,329,940) as applied to claim 1 above, further in view of Barthel et al. (5,921,917).

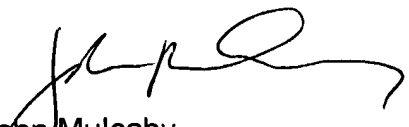
Art Unit: 3739

Adair fails to teach a diameter within the claimed range. However, Barthel et al. shows an analogous intubation system having a shaft with a diameter of 2.5 mm (col. 8, lines 30-35). It would have been obvious to the artisan to modify Adair by using a shaft having a diameter in the claimed range since Barthel et al. teaches such to be preferable.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John M. Mulcahy whose telephone number is (703) 308-3134. The examiner can normally be reached on M-F, 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C. M. Dvorak can be reached on (703) 308-0994. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0873.



John M. Mulcahy
September 12, 2002

John M. Mulcahy
Primary Examiner
Art Unit 3739